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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,078	01/25/2001	Katsuhiko Asai	15162/02750	4686

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EXAMINER	
JORGENSEN, LELAND R	
ART UNIT	**PAPER NUMBER**
2675	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/770,078	ASAI ET AL.	
	Examiner	Art Unit	
	Leland R. Jorgensen	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 3 - 31, and 35 - 47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1, 3 – 20, 24 – 31, and 45 – 47* is/are allowed.

6)☐ Claim(s) *21 – 23 and 35 - 43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 35 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Wecker et al., USPN 6,289,464 B1.

Claims 35 - 44

Wecker teaches a portable communication terminal [mobile device 10] comprising a display device [display 34] having memory capability [memory 22], a radio communication means [wireless receiver 27] for performing radio communication, and a power source [power supply 35] for supplying power to the communications means and the driver for driving the display device. Wecker, col. 4, lines 61 – 65; col. 5, line 35 – col. 6, line 24; and figures 2 & 4. Although Wecker does not specifically teach a driver for driving the display device to update a display on at least a portion of the display device, such driver would be inherent to the display taught by Wecker. Wecker teaches a controller [processor 20] for inhibiting simultaneous performing of radio communication and updating of at least a portion of the display device so as to limit a load on the power source. Wecker, col. 7, lines 22 – 46; col. 8, lines 44 – 50; and col. 18, lines 43 – 49.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 21 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al., USPN 6,068,183 in view of Valencia et al., USPN 5,380,991, and further in view of Schilling, USPN 5,359,182.

Claims 21 - 23

Freeman teaches a system and method of placing an advertisement on an electronic apparatus [chip card 10] having a display panel [display panel 14a - 14c]. Freeman, col. 3, lines 1 –5, 32 - 28; and figure 1A and 1C. The system includes setting means for setting the electronic apparatus so that predetermined information is displayed on the display panel if a predetermined service condition has been received. Freeman, col. 1, lines 50 – 64; col. 4, lines 7 – 10 and 60 – 65. The display panel maintains the display with no power supplied. Freeman, col. 3, lines 1 – 4; and col. 6, lines 12 – 17.

Valencia teaches an electronic apparatus [smart card 2] and method that maintains an identification number of the electronic apparatus and information on the presence or absence of a discount service. It is inherent that such material would be organized into a table. Valencia also teaches a counter for counting a usage charge and subtraction means for reducing the usage charge based on the registered information. Valencia, col. 3, lines 13 – 41; col. 4, lines 4 – 15,

37 – 51; col. 6, lines 40 – 44; col. 7, lines 13 – 17; col. 9, lines 30 – 53. Valencia also teaches a means for charging a user based on the reduced usage charge. Valencia, col. 3, lines 13 – 41; col. 4, lines 4 – 15, 37 – 51; col. 6, lines 40 – 44; col. 7, lines 13 – 17; col. 9, lines 30 – 53.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine detection of the services as taught by Valencia with the electronic apparatus as taught by Freeman. Valencia invites such combination by teaching,

> Current food industry practice in the promotion of brand name products generally falls into two categories: new product introduction for creating a demand for a particular product; and existing product promotion for the purpose of retaining or expanding current market share of a particular product. The standard method of promotion used to effectuate these purposes is to provide coupon offerings as price discount inducements to initially try or repurchase a particular product. Currently, the results of these efforts are not cost-effective or easily managed.
>
> Historically, a manufacturer or a retailer would produce a relatively large number of coupons, i.e. in the range of 20 to 50 million, and distribute these coupons to the public. Typically, these coupons would be printed in local or national publications, distributed to customers, mailed directly to potential customers or printed on the packaging of a product which is sold, all to induce the purchasing of this product by the consumer. Furthermore, once the coupon is redeemed by the customer at a retail center, such as a supermarket, the coupons are sent to a clearing house for redemption. If indeed 50 million coupons are printed, the approximate cost of producing and redeeming these coupons would be approximately $250,000.
>
> While many customers are inclined to utilize these coupons, due to the increasingly high costs of food and household items, the process of clipping and saving these coupons tends to be time-consuming and cumbersome. Furthermore, once these coupons are retained by the customer, the customer must remember to bring these coupons to the store for redemption. Often times, the customer will not bring his or her coupons when "running into the store" to make a quick purchase. Additionally, once the customer makes his or her purchases, the coupons associated with these purchases must be located among the coupons which the customer is not utilizing, the expiration dates of these coupons must be checked, and the coupons must then be given to the store clerk for scanning or otherwise entering the items into the store's computer. Once the store accumulates

> a number of coupons, they must then be sent to a redemption center, which in turn informs the various manufacturers of particular coupon usage.
>
> It is not suggested that, due to the tedious nature of this process discount coupons be eliminated, particularly since, due to the high cost of various products, such as breakfast cereals, the manufacturers would expect that customers would utilize discount coupons to make these products more affordable. Rather, it is suggested that a different system should be developed in which discounts can be applied to various products in a more economical and efficacious process.

Valencia, col. 1, lines 11 – 63. Valencia teaches about its invention.

> The present invention overcomes the deficiencies of the prior art by employing a paperless coupon redemption system, thereby avoiding the problems of the prior art in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house.

Valencia, col. 2, lines 51 – 58. Valencia invites one to consider different type of cards by adding,

> Although FIGS. 1 and 2 describe the construction of a typical IC or smart card, it is noted that the particular construction of this card is unimportant to the teachings of the present invention. What is important is the utilization of a card having an erasable, programmable memory as well as data processing capabilities, so that the information provided in the memory of the card can be compared to information contained in a computer system (and also in every card terminal) for updating the information contained in the card.

Valencia, col. 4, lines 27 – 36. Valencia further states,

> Since it is of paramount importance to determine whether a particular customer has previously purchased an item included in the progressive couponing technique, the customer's purchases must be tracked utilizing the smart card. Programmed into the erasable memory of the smart card would be a particular identification number associated with the customer, as well as an indication that a particular item subject to the progressive couponing system has been purchased. The smart card would then be updated by indicating an initial or subsequent purchase of an item subject to the progressive couponing system, as well as by deducting this discounted amount and any amounts discounted utilizing the "shop the dots" system from the customer's receipt total and the total amount presently listed in the card's memory.

Valencia, col. 6, lines 6 – 21. Valencia concludes with the desirability for the information to be tracked on each individual smart card.

> It is important to note that, while it is possible that a customer would purchase and completely utilize the discounts available in a single trip to a retail establishment, the system and method according to the present invention contemplates that the customer would retain his or her smart card and utilize it during several trips to one or more retail establishments. Indeed, the fact that the information relating to this customer identification number, and the products previously purchased by the customer, is maintained in the memory of the smart card, allows the customer to employ the smart card at various establishments which are not even linked to one another by a national, or central computer system. The smart card can be recharged with values up to 10,000 times and at any participating store.

Valencia, col. 9, lines 15 – 29.

Neither Freeman nor Valencia specifically teach that the usage is based on a use of the electronic apparatus.

Schilling teaches a wireless debit card that charges for the use of an electronic apparatus. Specifically, Schilling teaches a debit meter 100 coupled with a base station 50.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the debit card that charges for the use of an electronic apparatus as taught by Schilling with the electronic apparatus as taught by Freeman and Valencia. Schilling invite such combination by teaching,

> An object of the invention is a wireless debit card system which allows a user to prepay for telephone usage.
>
> Another object of the invention is a wireless debit card system which allows the user to receive telephone calls at a debit card telephone.
>
> A further object of the invention is a wireless debit card system wherein the telephone number follows the user on his debit card, as opposed to the telephone number being allocated to a specific telephone line.

> An additional object of the invention is a wireless debit card system using radio units for accessing telephone networks with smartcards as debit cards, wherein the smartcards are read by the radio unit.
>
> A further object of the invention is a wireless debit card system allowing telephones, facsimile machines, personal computers, automobiles, and the like to communicate using debit cards.
>
> A still further object of the invention is a wireless debit card system allowing users to use telephones, facsimile machines, personal computers, automobiles, and the like with telephone numbers which follow the user on his/her debit card, as opposed to the telephone number being allocated to a specific telephone line.

Schilling, col. 2, lines 33 – 56.

Response to Arguments

5. Applicant's arguments with respect to claims 21 – 23 and 35 - 43 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

6. Claims 1, 3 – 20, 24 – 31, and 45 – 47 are allowed.

7. The following is an examiner's statement of reasons for allowance:

Independent claims 1, 9, 24, 25, and 27 each teach an apparatus or terminal having a first and second display area or portion, with advertising information being displayed on the second display area and then being displayed on both the first and second display area when the apparatus is not operated for a predetermined period of time. Independent claim 20 is a method claim having a similar limitation. All remaining allowed claims are dependent on these claims.

In the prior action, examiner had rejected these claims under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Etheredge, USPN 5,990,890, Etheredge teaches a re-writable display panel having a first display area [pop-up menu 290] and a second display area [television listing guide 220]. Etheredge, col. 15, lines 16 – 23; col. 6, lines 55 – 56; and figure 15. The second display information [television listing guide 220] is changed from being displayed only on the second display area of the display panel to being displayed on both the first [that portion of the display formerly occupied by pop-up menu 290] and second display area when the operational element has not been operated for a predetermined amount of time. Etheredge, col. 14, lines 47 – 58; col. 15, lines 16 – 23; col. 23, lines 27 – 33 (claim 4); and figures 14 & 15.

In response, applicants amended these claims to state that the information is advertising information. Applicants then argued that Etheredge teaches that the advertising information is terminated rather than expanded after a period of inactivity. Examiner agrees. Although examiner has done further searches, examiner has found no prior art having advertising information in second display area that expands to include advertising information in both a first and second display area after a period of inactivity. Examiner has found prior art teaching that an advertising window will pop up as a screen saver after a predetermined time. See e.g. Reilly et al., USPN 5,740,549, and Schena et al., USPN 5,946,646. None of the prior art teaches that the advertising information is displayed in a second display area and then expands to fill a first and second display area.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Park et al., USPN 6,295,061 B1, and Slotznick, UPSN 6,011,537, each teach methods for presenting advertising on a computer display.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leland R. Jorgensen whose telephone number is 703-305-2650. The examiner can normally be reached on Monday through Friday, 7:00 a.m. through 3:30 p.m..

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DENNIS-DOON CHOW
PRIMARY EXAMINER